

## REMARKS

### Status

Claims 1, 3-13, 15-18, 20, 21 and 23-26 are pending, among which claims 1 and 16 are independent claims.

### Claim Rejections – 35 U.S.C. § 103

The rejection of claims 1, 3-5, 8, 10, 11, 16-18, 20, 21 and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Hennen in view of Matsuura et al. is respectfully traversed.

Both claims 1 and 16 call "wherein the polyurethane resin is obtained by reacting polyol and polyisocyanate, the polyol comprising at least one of polyester polyol and polyether polyol, and the polyisocyanate comprising at least one of aromatic polyisocyanate, aliphatic polyisocyanate, aromatic-aliphatic polyisocyanate and alicyclic polyisocyanate," (limitation X) and call "wherein an amount of the polyisocyanate to be compounded with respect to 100 parts by weight of the polyol is in the range of 1 to 30 parts by weight" (limitation Y). As discussed in the amendment previously submitted, these limitations X and Y are neither disclosed nor taught by Hennen.

Matsuura et al. discloses a hot-melt resin compound which comprises 1 to 30% by weight of a compound (A), which consists of  $Q - (X - A)_n$ , and 70 to 99% by weight of a thermoplastic polyurethane resin (B) (see col. 2, lines 27-36, and see also claim 1). In Matsuura, the thermoplastic polyurethane resin (B) may be obtained in such a manner as recited in above limitation X.

Please note, however, that Matsuura is silent about above limitation Y, i.e., the amount of the polyisocyanate to be compounded with respect to 100 parts by weight of the polyol falls within the range of 1 to 30 parts by weight. Matsuura only discloses a ratio between compound (A) and compound (B).

Although Matsuura states that compound (A) serves to improve the hot-melting property of compound (B) (col. 6, lines 63-65), it is believed that compound (A) and compound (B) do not react to each other. In  $Q - (X - A)_n$ , Q and A represent an isocyanate residue and an amine or alcohol residue (col. 2, lines 32-35). These

compounds do not react to each other under normal conditions. It is also believed that if they react to each other, compound (A) will no longer serve to improve the hot-melting property of compound (B). Also, in  $Q - (X - A)_n$ , X represents a urea group. However, since compound (A) and compound (B) do not react to each other, there will be no polyurethane-urea formed from compound (A) and compound (B).

Thus, Hennen and Matsuura, either alone or in combination, fail to teach the invention recited in claims 1 and 16, these claims should be allowable over Hennen and Matsuura. Since claims 1 and 16 should be allowable, so should their dependent claims.

**Claim Rejections – 35 U.S.C. § 103**

The rejection of claims 6, 7, 9, 12, 13, 15 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Hennen in view of Matsuura et al. and further in view of Shikinami et al. is respectfully traversed. Current claims 1 and 16 have overcome Shikinami because of the amendment previously submitted. Also, as explained above, claims 1 and 16 should be patentable over Hennen and Matsuura. Therefore, claims 6, 7, 9, 12, 13, 15 and 22 should also be patentable.

Respectfully submitted,



Tadashi Horie  
Registration No. 40,473  
Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200